

REMARKS/ARGUMENTS

In response to the Office Action mailed July 11, 2006, Applicants request reconsideration. No claims are cancelled, added, or amended in this Response. Claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-44 are pending.

What Claims Are Pending?

There have been continuing errors on the side of the U.S. Patent and Trademark Office in tracking what claims are pending in this patent application. Through several Office Actions, Applicants have requested the Examiner to correct both his comments in Office Actions and the PTOL-326 forms accompanying Office Actions. There has not been, in recent times, any correct statement of what claims are pending. In fact, the Official Records of the U.S. Patent and Trademark Office for this patent application, in the most recent Index of Claims found in the image file wrapper, is seriously in error.

The highest numbered claim pending in this patent application, as agreed by Applicants and the U.S. Patent and Trademark Office, is claim 44. Applicants and the U.S. Patent and Trademark Office records agree that claims 20, 21, 26, and 34 have been cancelled. However, U.S. Patent and Trademark Office records seem to have overlooked the cancellation of claim 16 in the Amendment filed May 16, 2003 and the cancellation of claims 3-6 and 10 in the Amendment filed July 15, 2004. These claim cancellations can be confirmed by consulting the image file wrapper for the identified Amendments. It is requested that the Official Records of the U.S. Patent and Trademark Office be corrected so that the list of claims pending and cancelled in this patent application is accurate.

The PTOL-326 form accompanying the Office Action mailed July 11, 2006 indicates that claims 1-19, 22-25, and 27-33, and 35-44 are pending. This statement is consistent with the records of the U.S. Patent and Trademark Office. However, the Office Action is, in its commentary, inconsistent with this statement and the records of

the U.S. Patent and Trademark Office. According to Applicants' representative, prior art rejections are made in the Office Action mailed July 11, 2006 as to claims 1, 2, 5-9, 11-15 and 17-43. Thus, the Office Action includes rejections of claims 5, 6, 20, 21, 26, and 34, claims that are not pending in this patent application and which have not been pending for some time. Further, there is no comment in the July 11, 2006 Office Action on claim 44, an independent claim added in the Amendment filed August 8, 2005 and acknowledged as pending in the Office Actions mailed September 29, 2005 and July 11, 2006.

The foregoing confusion raises questions for the Applicants as to whether their patent application is receiving detailed attention with respect to the claims pending and presented for examination. Therefore, it is requested that, at this stage, after another final rejection, the pending claims situation be clarified so that there is no fundamental issue as to which claims are pending in the event of a second appeal.

To assist the Examiner, attached as an Appendix is a reproduction of all claims now pending as well as an identification of the claims that have been cancelled. This listing of claims is taken from the Amendment after Final Rejection filed October 27, 2005. The claims filed there included some clerical amendments. According to the Advisory Action issued November 29, 2005, the claims as presented in that Amendment would be entered in the event of an appeal. A Notice of Appeal was filed December 21, 2005, so that the claims presented in the Amendment after final rejection filed October 27, 2005 are the claims pending in this patent application. It is those claims that are reproduced in the desire to establish a complete and correct record.

In view of the lack of congruity of the pending claims and of the commentary appearing in the Office Action mailed July 11, 2006, Applicants respond to the prior art rejections as understood and as apparently intended by the Examiner. If the claims should not be allowed, the Examiner is encouraged to present some comment explaining the grounds of rejection of claim 44 to avoid a formality issue in the event of another appeal.

The Claimed Invention

The claims are directed to a recorded computer program, a method, and a game machine in which a plurality of random numbers are generated and used in conjunction with other features of a game, and in determining the scenario of the game that leads a game player through various stages, and, if lucky, to a jackpot, i.e., big hit.

A key feature of the game described in the patent application is the unpredictability of the result. As extensively described in the patent application, the game according to the invention provides various scenarios in which characters meet and exchange words to produce various results that may not give the player a prize, that may shift a game to a special state, sometimes called a reach, without any opportunity to win a jackpot, or may provide a jackpot opportunity. In the embodiment of the invention disclosed in the patent application, for example, as shown in Figure 25, eight different events are controlled by random numbers that are generated within the game. Applicants do not rely on the quantity of the random numbers generated as distinguishing from the prior art, but do rely on the generation of random numbers **and** their use in novel ways to increase game variability, and thereby interest, in the scenarios developed through play of the game.

As shown in the table of Figure 25, among the random number counters that are employed in the game are a random number counter for determination of a production group, the fourth entry in the table of Figure 25, and a random number counter for production pattern determination, the eighth entry in the table of Figure 25. The use of each of the random numbers listed in that table is described at various locations within the original specification, which is referred to in order to point out that the original disclosure supports this description and the claims. For example, the use of eight different random numbers and their generation in the described embodiment is supported by the passages of the original specification, not the

substitute specification, from page 30, line 14 through page 31, line 1, page 31, line 18 through page 32, line 5, and page 36, lines 14-17.

In the embodiment of the game described in the patent application, the course of the game can follow various paths as shown in the numerous flowcharts that are part of the application. Attention is particularly directed to the right half of the flowchart of Figure 20 which illustrates features of the described embodiment of the invention. The left half of the flow chart of Figure 20 is directed to a demonstration or attractive display, intending to attract a player to a game machine that is currently idle. As shown at that right half of Figure 20, serial tests are applied to determine whether a jackpot, i.e., big hit, situation is established. If not, a similar test is applied to determine whether a special state, the reach state, has been achieved. No matter which of the three potential results of these tests is obtained, the three flows extend to determination of a production group, as shown at steps ST38, ST40, and ST42. These production groups are chosen from groups in the one of the production group determination tables that is selected. A separate table is provided for each of the respective test outcomes, i.e., steps ST38, ST40, and ST42, of Figure 20.

Examples of production group determination tables are illustrated in Figure 28 where it can be seen that each of the production group determination tables includes at least one production group. Each production group has a corresponding number or range of numbers. One of those production groups is selected based upon the number matching a random number generated for production group determination, the first random number of the claims. That random number is the fourth entry in the table of Figure 25. These features, namely selecting a particular production group determination table, and the inclusion in the production group determination tables of production groups with corresponding numbers or ranges of numbers, are described in the original specification from page 33, line 29 through page 34, line 4, page 34, lines 21-25, and page 35, lines 6-10. These passages explain that the production group determination tables are stored in a read-only memory.

As further shown in the flowchart of Figure 24 and described in the original specification at page 37, beginning in line 20, once a production group is determined, a production pattern determination table corresponding to the determined production group is selected. Examples of such production pattern determination tables are shown in each of Figures 31-36 of the patent application. Each production pattern determination table includes multiple production patterns with corresponding numbers. Consultation with Figures 31-36 shows the production patterns of displays and exchanges of words between the characters. When these production patterns are displayed in combination, they make up a scenario leading to the next stage or the final outcome of the game. The particular production patterns selected depend upon the generation of another random number, the second random number of the claims. That random number is the eighth entry in the table of Figure 25 of the patent application. When this random number is generated, it is matched to numbers associated with the production patterns to determine particular production patterns that produce the production display. The use of random numbers in producing the resulting production display is described in detail in the original specification from page 37, line 20 through page 39, line 6. As with the production group determination tables, the production pattern determination tables are likewise stored in a read-only memory of the game.

As just described, in the invention, there is a hierarchy of elements with respect to random number-based selection processes that determine the displays, widely expanding the variability of the potential displays, the results, and interest in the game involving the two characters and scenarios. Stated another way, the invention provides a wider array of possibilities, producing greater player interest, and resulting in greater revenue for the owner of the game. In the invention, the hierarchy consists of the two sets of determination tables. The first set includes the production group determination tables that are selected based upon initial stages of the game play, and that have an associated set of numbers for each production group within each table. Upon the selection of a production group, through use of a different random number,

selections are made from production pattern determination tables, the second tables, that, in turn, include production pattern entries with their own numbers. Thus, upon the generation of the two different random numbers and the intermediate application to the production group determination tables, production groups, production pattern determination tables, and production patterns, the ultimate production displays are provided. This hierarchy is the “nesting” referred to below that, among other features, distinguishes the claimed invention from the prior art.

Prior Art Rejections

Of the independent claims, claims 1, 11, 23, 31, and 32 were rejected as unpatentable over Ugawa (JP 9-56896) in view of Durham (U.S. Patent 5,456,465). This rejection is respectfully traversed as to the rejected independent claims and any and all dependent claims that depend from those independent claims (i.e., dependent claims 2, 7-9, 24, 25, and 27-30).

Durham was cited as supporting the Examiner’s assertion that it is notoriously well known to use look-up tables in read-only memories to store game images in gaming machines and to use a random number generator to select the particular image displayed. Durham does not stand for this proposition and is not even particularly relevant to the invention as defined by the pending claims.

Applicants agree that Ugawa, the principal reference, describes the use of random numbers in determining various displays in a game machine. Applicants supplied, as an attachment to the Amendment filed August 28, 2005, an English language translation of six paragraphs of Ugawa. Attention was particularly directed to paragraph [0021]. That passage describes the use in Ugawa of five different random numbers to determine various display elements. In fact, the embodiment of the invention described in the patent application uses five essentially similar random numbers to achieve the same choices and display elements. Those corresponding five random numbers and the elements they determine correspond to entries 1, 2, 5, 6, and 7 of Table 25 of the present patent application. Nothing in the translated paragraphs

of Ugawa or in other paragraphs of Ugawa supplies or suggests the use of further random numbers, as in the invention, or production group determination tables, or production pattern determination tables, with the hierarchies of those tables as in the invention.

Further, as explained in translated paragraphs [0034]-[0036] of Ugawa, the indication given to a game player, referred to as a notification in Ugawa, is unchanging. This notification, i.e., referred to as predictive notification, suggesting to the player the course of development of the game, lacks variety. As particularly pointed out in the final paragraph of the three cited paragraphs, and shown in Figures 36(A) and 36(B) of Ugawa, a character merely enters the display carrying a sign telling the game player the state of the path of development of the game. Thus, Ugawa lacks not only the specifics of the invention as defined in the amended claims, but also lacks the advantage of the invention, namely wide variability of displays resulting from the hierarchy of production groups and production patterns.

Durham was apparently cited because it pertains to a slot machine that uses two random number generators. As explained in Durham, at the time a player of the slot machine inserts a coin, before the game operates, a decision is made as to whether the game will provide a winning or losing result. The determination is made by generating two random numbers and multiplying those random numbers together to provide a payout value. The payout value may be zero in the case of a loss. Durham also describes a plurality of payoff values, nine according to the example of Durham, although only six such examples are illustrated in Figure 7 of Durham. Once the payout value is determined, in advance of the game operation, then a decision is made as to where the three reels of the slot machine are to stop spinning to display a combination corresponding to the payout determined. In some instances only a single element on each reel can produce the combination display corresponding to the determined payout value. In those situations there is no further choice to be made as to the stopped position of the reels in Durham. For some payouts, more than one combination of symbols on the stopped reels will provide that payout. An example

including eight potential ways to display a single payoff value of 100 is described in detail in Durham. In that example, since only one of payout combinations can be displayed on the stopped reels, a random number from 1 to 8 is selected by the microprocessor. That number is used to determine which of the eight combinations is displayed. The outcome is not changed by whichever number is selected, but the multiple possible displays providing the same predetermined payout, according to Durham, “adds an element of *apparent* randomness to the game.” Durham at column 4, lines 14 and 15, emphasis added. How selection of one of eight displays, all of which are identical and indistinguishable to the viewer, adds even apparent randomness to the slot machine is not further explained by Durham.

In other words, although Durham describes employing two random numbers, and, in some instances, a third random number, fewer than the number of random numbers employed by Ugawa, there is really no variability of the display of Durham. Even Durham is only willing to state that his arrangement provides a “apparent” randomness to the game. Moreover, Durham, like Ugawa, does not use the random numbers that are generated in anything like production group determination tables or production pattern determination tables, as in the invention. Not even the basic concept of the “nested” tables selected using random numbers as in the invention is described in Durham or, for that matter, in Ugawa. Therefore, no modification of Ugawa with Durham could include all of the limitations of independent claims 1, 11, 23, 31, or 32 as asserted in the Office Action. For that reason, upon reconsideration, the rejection of those claims and their dependent claims 2, 7-9, 24, 25, and 27-30 should be withdrawn and those claims should now be allowed.

In addition, the construction of Durham in the Office Action is incorrect. At page 4, the Examiner stated that the payout amount determined in Durham is a “game state”. Even an elementary comparison of the payout amount to claim 1, in the final paragraphs of that claim, makes clear that a payout amount cannot be a game state that, for example, changes if the varying display “stops an additional special symbol at a specific stop arrangement.” The disclosure of Durham simply does not relate to the

claimed invention or to Ugawa. The foregoing analysis on Durham is not an attack on Durham or Ugawa individually; it is an attack on the basis of the rejection.

Further, even if all of the limitations of the enumerated claims were disclosed in one or the other of Ugawa and Durham, *prima facie* obviousness could not be established unless there were motivation to modify Ugawa with Durham. As best understood, Durham was relied upon for the decision as to which of a plurality of identical displays, representing a predetermined payout, will be shown. That is, Durham makes a determination as to where the reels will stop turning when multiple choices producing the same result exist. Where is there such an ambiguity in Ugawa that needs a resolution such as provided by Durham? There is no such ambiguity so that Durham would not be used to modify Ugawa. Therefore, there is no motivation for modifying Ugawa with Durham.

Likewise, why would Durham be used to add "variety" to the Ugawa game as alleged at page 4 of the Office Action? There is no teaching in Ugawa that more variety is needed. Further, Durham even states that it does not provide more variety in a game, only an "apparent randomness" in the payout display. Durham must have been chosen and its teachings interpreted with hindsight knowledge of the invention in an attempt to construct an assertion of *prima facie* obviousness of the claimed invention. Hindsight reconstruction is a prohibited basis for asserting obviousness. Yet hindsight is the only explanation for the combination made here since there truly is no motivation in Ugawa, Durham, or knowledge in the art, for modifying Ugawa with Durham. On this second basis, the first rejection is erroneous and should be withdrawn.

Independent claims 12, 17, 22, 33, 35, 39, and 43 were rejected as unpatentable over Ugawa in view of Fuchs (U.S. Patent 5, 630,753), and further in view of Durham. This rejection is respectfully traversed as to the rejected independent claims and any and all of their dependent claims, namely claims 13-15, 36-38, and 40-42.

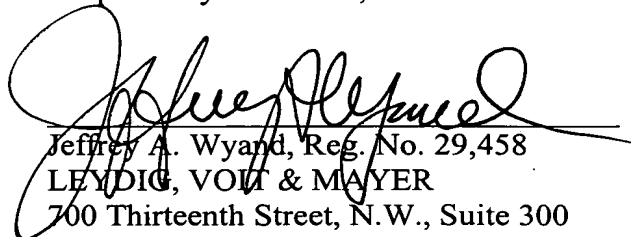
Essentially, the second rejection is based upon the same reasoning as the first rejection, with the additional citation of Fuchs as disclosing a help-table explaining

odds of winning. This table was analogized by the Examiner to the suggestion display of claim 12 and the other rejected claims. Even if such a disclosure is present in Fuchs and if Fuchs suggests some modification of Ugawa and Durham, the combination still cannot suggest the invention as defined by the pending claims for the same reasons already presented with regard to the first prior art rejection. Fuchs only potentially makes any claim obvious if the basic invention defined by claims 12, 17, 22, 33, 35, 39, and 43 is obvious in view of Ugawa, as modified by Durham. However, the discussion of the first rejection shows that even that hypothetical modification fails to suggest the use of random numbers with nested or hierarchical tables to make selections from production group determination tables and production pattern determination tables as in the invention. Accordingly, those comments regarding the first rejection are incorporated by reference and demonstrate the error in the second rejection. Reconsideration of this rejection and allowance of claims 12-15, 17, 22, 33, and 35-43 are earnestly solicited.

Conclusion

For the foregoing reasons, all claims now pending are patentable over any possible combination of Ugawa, Durham, and Fuchs so that, upon reconsideration, those claims should be allowed.

Respectfully submitted,


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